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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/576,094	05/22/2000	Miles A. Galin	A31632-A	2498

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NEW YORK, NY 10112

EXAMINER

CHATTOPADHYAY, URMI

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 11/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding..

S.M.

<b>Office Action Summary</b>	Application No. 09/576,094	Applicant(s) GALIN, MILES A.	
	Examiner Urmi Chattopadhyay	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 September 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 5-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 5-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 May 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

## **DETAILED ACTION**

### ***Request for Continued Examination***

1. The request filed on 9/24/02 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on Application No. 09/576,094 is acceptable and a RCE has been established. An action on the RCE follows.

### ***Response to Amendment***

2. The Amendment filed 9/24/02 has been entered as Paper No. 9. Changes to the abstract have been approved by the Examiner and claim 4 has been canceled.

### ***Claim Objections***

3. Claim 12 is objected to because of the following informalities: line 2, "to" should be changed to --of--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 5 is indefinite because it states that each of the two haptic has a four point attachment. This is inaccurate according to page 14, lines 4-8, which states that haptics (two) provide for a four-point attachment.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1 and 8-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Hoffmann et al. (USPN 6,228,115).

Hoffmann et al. discloses an intraocular lens with all the limitations of claim 1. See Figure 1 for positive power (column 6, lines 47-48) anterior chamber ocular implant for placement in the anterior chamber of a phakic eye (column 3, lines 45-48). See column 6, lines 49-50 for lens having at least one convex surface and Figure 2 for means for positioning (32) the

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lens (28) in the anterior chamber of the eye, wherein contact between the artificial lens and other anatomic bodies is avoided (columns 2-3, lines 64-3).

Claim 8, see column 6, lines 5-39 for artificial lens material.

Claims 9 and 10, see column 6, lines 40-46 for refracting lens being foldable or rigid.

Claim 11, see any one of Figures 3-8, 9 and 10 for the means for positioning comprising two haptics (32) normal to the peripheral edge of the positive artificial refracting lens.

### *Claim Rejections - 35 USC § 103*

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffmann et al. in view of Kelman (USPN 4,871,363 as cited in previous office action).

Hoffmann et al. discloses an intraocular lens with all the limitations of claim 1, but is silent to the additional limitation of the haptics each having an “S” configuration, and what Examiner is interpreting as the haptics together having a four point attachment with an intermediate beam length of 5.25mm, as required by claims 5 and 12. Examiner contends that the lens of Hoffmann et al. can be used with several types of haptic arrangements that are well known in the art without destroying the ability of the lens to be used as a positive refracting power anterior chamber ocular implant. For example, Kelman teaches a corrective anterior chamber intraocular lens for use in a phakic eye with “S” configured haptics with four point

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attachments in order to engage adjacent portions of the eye tissue for stable fixation when inserted for implantation. See Figure 4 and column 7, lines 3-10. This arrangement of haptics also allows for the eye incision to be minimized to the diameter of the lens body and for snaking in the leading haptic to minimize the risk of contact with the natural lens by the IOL during implantation. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention combine the positive refractive lens of Hoffmann et al., especially when made of a rigid material, with the with "S" shaped haptics with four point attachments of Kelman. Kelman does not specifically state that the intermediate beam length be 5.25mm (column 7, lines 11-23), however, a clear criticality of this value is absent in being shown. It would have been obvious to one of ordinary skill in the art to modify the beam length to fit the size and shape of the individual patient, therefore meeting the limitation.

10. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffmann et al. in view of Li (USPN 6,132,462 as cited in previous office action).

Hoffmann et al. discloses an intraocular lens with all the limitations of claim 1, but is silent to the additional limitation of the implant being coated with a specific sulfated polysaccharide medicament, as required by claims 6 and 7. Li teaches a copolymer intraocular lens coated with heparin in order to raise biocompatibility and prevent deposition of cells. See column 6, lines 19-29. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to look to the teachings of Kelman to modify the intraocular lens of Hoffmann et al. have the specific coating in order to raise biocompatibility and prevent deposition of cells.

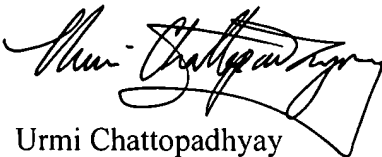
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*Response to Arguments*

11. Applicant's arguments with respect to claims 1 and 5-12 have been considered but are moot in view of the new ground(s) of rejection.

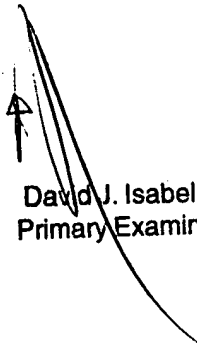
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Urmi Chattopadhyay whose telephone number is (703) 308-8510 and whose work schedule is Monday-Friday, 9:00am – 6:30pm with every other Friday off. The examiner's supervisor, Corrine McDermott, may be reached at (703) 308-2111. The group receptionist may be reached at (703) 308-0858.

Should the applicant wish to send a fax for official entry into the file wrapper the Group fax number is (703) 305-3590. Should applicant wish to send a fax for discussion purposes only, the art unit fax number is (703) 308-2708.



Urmi Chattopadhyay

Art Unit 3738



David J. Isabella  
Primary Examiner

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October 21, 2002